

## REMARKS

The Examiner is thanked for the Official Action dated September 9, 2004. This Amendment and Request for Reconsideration is intended to be fully responsive to the Official Action.

In the Official Action, Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,763,606 to Saida in view of U.S. Patent 3,745,306 to Naritomi. Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Saida in view of Naritomi as applied to claim 1, and further in view of U.S. Patent 4,910,385 to Shye-Long.

With regard to the portion of the rejection based on the Saida reference, Sadia was filed August 9, 2002 and, therefore, qualifies as prior art under 35 USC 102 (e) only. Attached to this Response is an Affidavit submitted under 37 CFR 131 in which an inventor (Yoshihisa Ura) declares that the current invention was in his possession as of July 10, 2002 at the latest. The Affidavit includes documentary exhibits supporting the inventor's declaration. A table addressing each of the elements of original independent claim 1 is also included.

It is respectfully submitted that the enclosed Affidavit "swears back" or proves a "date of invention" of July 10, 2002 at the latest, and thereby removes the Sadia reference from consideration. Based on the removal of the Sadia reference, the applicant submits that the current application is now in condition for allowance.

Further, even in the absence of the attached Affidavit, the current invention is defined over the prior art. With regard to the 35 U.S.C. 103 rejection of claim 1, although Saida teaches a steam generating unit that includes an ionizing particle generator (Figure 5 of Saida), the Saida steam generator is not adapted for use with a handpiece as claimed in claim 1. More importantly, Saida fails to teach or suggest a device that can selectively choose steam only, or ionic particles only, or readily switch from steam to ionic particles, or to a combination of steam and ionic particles as recited in claim 1.

Naritomi teaches a hand-held steamer in combination with an electric blower.

In the portions of the references cited by the examiner, neither Saida nor Naritomi teaches a handheld device that can generate ion particles alone. Thus, the combination of Saida and Naritomi fails to teach every aspect of the claimed invention – even if such a combination was possible. For this reason alone, the rejection of original claims 1 and 2 must fail.

Saida in combination with Naritomi teaches a stationary base unit that emits steam and ionic particles, and a handheld unit that emits steam and may also blow air via an electric blower. Neither Naritomi nor Saida either alone or in combination, suggests a hand held device in which a user can select an emission of ionic particles either alone, or in combination with steam, as specifically claimed in claim 1.

With regard to the court case cited by the examiner (Nerwin v. Erlichman, 168 USPQ 177, 179 (Patent Office Board of Interferences 1969)), the case actually says “The mere fact that a given structure is integral does not preclude its consisting of

various elements” (column 1, paragraph 6). The case does not stand for the proposition indicated by the examiner and is not applicable with regard to the examiner’s rejection of the current invention. A more appropriate reference is MPEP 2143.03, which indicates that all the claimed limitations must be taught or suggested by the prior art. As indicated above, none of the prior art references, either alone or in combination, suggests a handpiece movably attached to a main unit in which a user can select either ionic particles, steam, or a combination of steam and ionic particles.

Further, even if the prior art, in combination, taught the claimed limitations, the examiner does not identify a statement in the prior art indicating why one of ordinary skill in the art would be motivated to combine the stationary base unit taught in Saida with the hand-held steam blower taught in Naritomi. In accordance with MPEP 2143.01, without a motivation to combine the references, the rejection is improper; the prior art must suggest the desirability of the claimed invention.


The examiner has attempted to reconstruct the claimed invention through modifications that are not suggested in the prior art and through means that are not obvious to one of ordinary skill in the art. The result of the multiple modifications and obvious statements proposed by the examiner is an apparatus clearly created in hindsight. To imbue one of ordinary skill in the art with the knowledge of the invention when no proper art references suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against the teacher. W.L. Gore & Associates, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983).

It is respectfully submitted that for the foregoing reasons, claim 1 is distinguished over the prior art and is in condition for allowance. With regard to claim 2, claim 2 is dependent on claim 1 and is therefore also in condition for allowance.

With regard to new claims 3-16, claims 3-16 have been added to provide additional structure and to further distinguish the invention over the prior art. Specifically, claim 3 claims an operating system that selectively controls the steam generating and injecting unit, as well as the ion generating and injecting unit so that when a trigger switch on a moveable handpiece is activated, either ions, steam, or a combination of steam and ions are emitted from the handpiece applicator head. Claims 4-16 include additional distinguishing features.

It is submitted that the foregoing arguments and amendments resolve all outstanding issues and place this application in condition for allowance. If the examiner believes that additional discussion would advance the prosecution of the present invention, she is encouraged to contact the undersigned at the phone number listed below. It is believed that no charges are due for this submission. However, if this is incorrect, then please debit Account 50-0548 and notify the undersigned.

Respectfully submitted,

  
Matthew W. Stavish  
Registration No. 36,286

Liniak, Berenato & White

6550 Rock Spring Drive  
Suite 240  
Bethesda, Maryland 20817  
(301) 896-0600

MWS/rdj